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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/590,703

08/25/2006

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EXAMINER

YAMNITZKY, MARIE ROSE

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

02/18/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/590,703	Applicant(s) OHSAWA ET AL.	
	Examiner Marie R. Yamnitzky	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 November 2009 and 22 January 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 50-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 68-70, 73 and 74 is/are allowed.
- 6) ☒ Claim(s) 50-67, 71 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>09 Nov 2009</u> . | 6) <input type="checkbox"/> Other: _____ |

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1. This Office action is in response to applicant's amendment filed November 09, 2009, which amends claims 56 and 65.

Claims 50-74 are pending.

2. This Office action is also in response to the terminal disclaimer filed November 09, 2009, and the certified translations filed January 22, 2010 of foreign priority applications JP 2004-151035, JP 2004-226382 and JP 2004-231742.

3. The documents listed in the Information Disclosure Statement filed November 09, 2009 have been considered and are made of record.

4. The terminal disclaimer filed on November 09, 2009, disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of Patent No. 7,238,806, has been reviewed and is accepted. The terminal disclaimer has been recorded.

5. The rejection of claims 56 and 65 under 35 U.S.C. 112, 2nd paragraph, as set forth in the Office action mailed August 07, 2009 is overcome by claim amendment.

The rejection under 35 U.S.C. 103(a) based on Inoue et al. (US 7,238,806 B2) is withdrawn in consideration of the certified translation filed January 22, 2010 of foreign priority application JP 2004-226382.

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The rejection under 35 U.S.C. 103(a) based on Fujii et al. (US 2005/0191527 A1) is withdrawn in consideration of the certified translation filed January 22, 2010 of foreign priority application JP 2004-226382.

The obviousness-type double patenting rejection based on U.S. Patent No. 7,238,806 B2 in view of Igarashi et al. (US 2001/0019782 A1) is overcome by the terminal disclaimer filed November 09, 2009.

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 50-57, 59-66, 71 and 72 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-9, 13, 15 and 16 of

compending Application No. 11/797,532. Although the conflicting claims are not identical, they are not patentably distinct from each other because there is substantial overlap between the organometallic complex as claimed in present claims 50-57, 59-66, 71 and 72 and the organometallic complex as claimed in compending claims 6-9, 13, 15 and 16.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

8. Claims 58 and 67 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 6-9, 13, 15 and 16 of compending Application No. 11/797,532 in view of Igarashi et al. (US 2001/0019782 A1).

There is substantial overlap between the organometallic complex as required for the light emitting device of present claims 58 and 67 and the organometallic complex as claimed in compending claims 6-9, 13, 15 and 16. While the compending claims do not claim a light emitting device comprising the complex, Igarashi et al. demonstrate that it was known in the art at the time of the invention that similar complexes could be used in the light emitting layer of a light emitting device comprising a light emitting layer disposed between a pair of electrodes. For example, see paragraphs [0041]-[0044], [0135] and [0137], and see formula (1-70) on page 17 of the Igarashi reference. Having knowledge of the teachings of Igarashi et al., one of ordinary skill in the art at the time of the invention would have reasonably expected that complexes as claimed in compending claims 6-9, 13, 15 and 16 could be used in a light emitting device having a light emitting layer disposed between a pair of electrodes.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Copending Application No. 11/797,532 has an earlier effective U.S. filing date than the present application. Accordingly, the provisional obviousness-type double patenting rejections are maintained absent a terminal disclaimer, or amendment of the present or copending claims which overcomes the rejections. See MPEP 804 I.B.1.

10. Claims 68-70, 73 and 74 stand allowed.

11. Applicant is hereby advised that, in addition to the provisional obviousness-type double patenting rejections, further consideration of present claims 50-67, 71 and 72 will be required under 35 U.S.C. 135 upon resolution of all rejections. If applicant's representative wants to discuss possible further amendments to claims 50-67, 71 and 72 that would remove the requirement for further consideration under 35 U.S.C. 135, an interview with the examiner at a mutually agreeable time can be arranged by telephoning the examiner at the telephone number listed below.

Further consideration under 35 U.S.C. 135 is not required for allowed claims 68-70, 73 and 74.

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12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

13. Any inquiry concerning this communication should be directed to Marie R. Yamnitzky at telephone number (571) 272-1531. The examiner works a flexible schedule but can generally be reached at this number from 7:00 a.m. to 3:30 p.m. Monday and Wednesday-Friday.

The current fax number for all official faxes is (571) 273-8300. (Unofficial faxes to be sent directly to examiner Yamnitzky can be sent to (571) 273-1531.)

/Marie R. Yamnitzky/
Primary Examiner, Art Unit 1794

MRY
February 09, 2010